

and error messages from the equipment that are (sic) part of the network (See Figs. 1 and 2; column 3 lines 19-35 and column 7 line 61-column 8 line 5). The handheld computer furthermore has a ‘user interface’ to enter commands (See Fig. 3) and the computer is coupled to the network through a (sic) RS-232 port or ‘a serial port for coupling to the network (See Figs. 1, 2, and 2B; column 7 lines 8-20).”

The Examiner concedes that “Budinger does not disclose (1) creating ‘second information for communication over the network’ and (2) a ‘signature pad’.”

The Examiner relied upon Chappell to teach

“a system for testing a CATV system (See Fig. 1). Chappell discloses a mobile field client that is able to connect to the CATV network. The technician is able to test upstream communications by entering data into the field client that will be sent to the headend or ‘second information for communication over the network’. The results from the message are sent back to the field client in order for the technician to determine the condition of the CATV system (See column 5 line 59-column 6 line 30). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the handheld computer disclosed by Budinger to perform testing on the reverse path by creating ‘second information for communication over the network’, as taught by Chappell, in order to increase the testing capabilities of the handheld computer thereby providing the user with more tools to troubleshoot the network with.”

The Examiner relied upon Valliani to teach

“a handheld computer or PDA (See Fig. 6). Valliani discloses that the PDA can have an additional module attached to the PDA to accept signatures on a signature unit. The signature is then transmitted over the network (See Fig. 6; column 7 lines 30-48). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the handheld computer disclosed by Budinger to be able to attach an additional signature unit or ‘signature pad’, as taught by Valliani, in order to expand the capabilities of the handheld computer thereby providing a means for receiving signatures from customers that authorizes services to be performed.

Furthermore, when the signature unit is attached to the handheld computer it is also coupled to the serial port of the handheld computer permitting transmission of the signature pad-related signals over the network (See Budinger Fig. 2A and 2B and Valliani Fig. 6).”

Setting aside for the time being whether it would have been 35 U. S. C. § 103 obvious to combine Budinger and Chappell in the way the Examiner has suggested, Valliani

discloses

“a PCMCIA-compliant generic laptop computer or personal digital assistant (“PDA”) device with an add-on module that provides point of sale functionality. Essentially the module converts the device to a portable inexpensive point of sale transaction terminal.”

Valliani’s abstract. PCMCIA is a parallel interface, not a serial one. Accordingly, Valliani neither discloses nor suggests providing claim 11’s specifically recited “serial port for coupling the second information to the network, and a signature pad coupled to the serial port,” or claim 27’s specifically recited “ethernet interface for coupling the second information to the network, and a signature pad coupled to the ethernet interface.”

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness (citing In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984)). Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 548 (Fed. Cir. 1985).

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). M.P.E.P. 2142.

[V]irtually all [inventions] are combinations of old elements. *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 U.S.P.Q. 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 U.S.P.Q. 8, 12 (Fed.Cir.1983) (“Most, if not all, inventions are combinations and mostly of old elements.”). An examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.

In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998), citing

Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ.2d 1551, 1554 (Fed. Cir. 1996). The factual inquiry whether to combine references must be thorough and searching. In re Lee, 61 U. S. P. Q. 2d 1430, 1533 (Fed. Cir. 2002). Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). The Examiner must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 149 F.3d at 1359, 47 USPQ2d at 1459.

It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to “[use] that which the inventor taught against its teacher.” W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.

In re Lee, 61 USPQ2d at 1435.

In rejecting independent claims 11 and 27, the Examiner has not identified any reason why or proposed how one would combine Valliani’s parallel PCMCIA architecture signature pad coupled to Valliani’s PCMCIA-compliant laptop computer or PDA with Budinger’s wireless IR, RF or LAN serial port architecture. Certainly, a PCMCIA signature pad is incompatible with a wireless IR, RF or LAN serial port. The Examiner appears to be using hindsight reconstruction as a substitute for a factual basis for the rejection of the claims under 35 U. S. C. §103. Such use of hindsight reconstruction is not proper. “There must be a reason apparent at the time the invention was made to a person of ordinary skill in the art for applying the teaching at hand, or the use of the teaching as evidence of obviousness will entail prohibited hindsight.” In re Nomiya, Kohisa, and Matsumura, 509 F.2d 566, 184 USPQ 607 (CCPA 1975). “The Patent Office has the initial duty of supplying a factual basis for a rejection under 35 U. S. C. § 103. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.” In re Rice, 481 F.2d 1316, 178 USPQ 478, 479 (CCPA 1973).

The Examiner has located a new reference, Valliani, disclosing a system using a signature capture unit, combined it with other references that the Examiner had already considered, Budinger and Chappell, and rejected the claims on the ground of obviousness.

None of Budinger, Chappell or Valliani hinted that a device constructed as described in Budinger, Chappell or Valliani was deficient in testing capabilities, or needed more tools to troubleshoot networks with, or required a means for receiving signatures from customers that authorizes services to be performed. None of Budinger, Chappell or Valliani even hinted at how its teachings might be combined with or into the teachings of any of the others of Budinger, Chappell or Valliani, and with good reason. None of Budinger, Chappell or Valliani ever even contemplated that there was any point to such a combination, any benefit to be gained by such a combination, or any reason why one would ever contemplate such a combination. Applicants were the ones to do that. The Examiner's rationale for the Budinger/Chappell combination and the Budinger/Valliani combination, *in order to increase the testing capabilities of the handheld computer thereby providing the user with more tools to troubleshoot the network with [and] thereby providing a means for receiving signatures from customers that authorizes services to be performed*, can be distilled down to, *in order to arrive at the claimed invention*. This is not what is contemplated by 35 U. S. C. § 103. Plainly, this is a case of prohibited hindsight reconstruction. Without identifying any teaching, motivation, or suggestion in Budinger, Chappell or Valliani that supports the need to modify and combine the references, the Examiner's reason for the rejection is not sufficient. Applicants request that the rejection based on the combination be withdrawn.

For at least these reasons, Applicants submit that independent claims 11 and 27 are entitled to favorable consideration, culminating in allowance. Such action is respectfully requested.

Claims 12, 28, 35, 36, 42-47 and 51-58, depend directly or indirectly upon claims 11 and 27, and are allowable at least for the reasons discussed above in regard to claims 11 and 27. Reconsideration and allowance of claims 12, 28, 35, 36, 42-47, and 51-58 are respectfully requested.

The Examiner rejected claims 48-50 and 59-61 under 35 U. S. C. § 103. The Examiner relied upon the combination of Budinger, Chappell, Valliani and Chang U. S. Patent 6,891,803 (hereinafter Chang) to support this rejection.

The weaknesses of the underlying combination of Budinger, Chappell and Valliani are set forth in detail above, and are incorporated by reference here. Chang adds nothing to the Budinger/Chappell/Valliani combination to overcome the above noted infirmity of the Budinger/Chappell/Valliani combination. Again, without identifying any teaching, motivation, or suggestion *in Budinger, Chappell, Valliani or Chang* that supports the need to modify and combine the references, the Examiner's rationale for the combination

evaporates. Claims 48-50 and 59-61, which depend directly or indirectly upon claims 11 and 27, are allowable at least for the reasons discussed above in regards to claims 11 and 27. Reconsideration and allowance of claims 48-50 and 59-61 are respectfully requested.

The Commissioner is hereby authorized to charge any fees which may be required to constitute this a timely response to the May 16, 2006 official action, to Applicants' undersigned counsel's deposit account 10-0435 with reference to file 6573-68375. A duplicate copy of this authorization is enclosed for that purpose.

Respectfully submitted,



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